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EXHIBIT C

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UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

v.

NEW DESTINY INTERNET GROUP, ET AL.,

Defendants.

AND REFERENCED CONSOLIDATED AND RELATED CASE

Consolidated Cases:
SA CV 02-1040 JW (MLGx)
SA CV 02-1165-JW (MLGx)
SA CV 03-0218-JW (MLGx)
SA CV 02-1048-JW (MLGx)
SA CV 03-0219-JW (MLGx)
SA CV 03-0308-JW (MLGx)
SA CV 03-0271-JW (MLGx)
SA CV 03-0259-JW (MLGx)
SA CV 02-1063-JW (MLGx)

Related Cases:
SA CV 03-1801 JW (MLGx)
SA CV 03-1803 JW (MLGx)
SA CV 03-1804 JW (MLGx)
SA CV 03-1807 JW (MLGx)

DEFENDANTS' CLAIM CONSTRUCTION BRIEF REGARDING UNITED STATES PATENT NO. 6,144,702

Date: May 18-20, 2004
Time: 9:30 a.m.
Ctrm: 9C

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I. INTRODUCTION

Defendants respectfully submit this *Markman* brief addressing terms in the '702 patent-in-suit.

Issued nearly a decade after the applicants first filed the application for the '992 patent, and after use of the Internet had become widespread (and, consequently, well-known to applicants), the '702 patent claims a "communication system" that is a combination of both a transmission and a reception system. Unlike the transmission and reception systems claimed in the '992 patent, previously considered by the Court, the constituent transmission and reception systems of the '702 patent are claimed more broadly. This is the case because, in prosecuting this patent, the applicants eliminated "inconvenient" limitations present in the '992 patent, which, while they were the basis for patentability of that patent (and others preceding the '702 patent), no one had seen fit to use. For example, the claims of the '702 patent eliminate the "remote locations" limitation featured so prominently in prior patents in the chain. The claims also nearly eliminate the "source material library," another critical aspect of the transmission system.

Because the patentees eliminated these and other key elements, the patentees secured the '702 patent only by defining their alleged invention as a combination of the now-denuded transmission and reception systems. In so doing, however, the applicants continued to employ functional terms, such as "identification encoder," without permissible corresponding structure, as well as new functional terms found nowhere in the patent, such as "sequence encoder."

Remarkably, in view of the necessity of having both transmission and receiving systems to secure allowance, Acacia has accused Defendants of infringing the '702 patent even though they do not make, use, offer for sale, or sell reception systems. Rather than employ the '702 patent as might be proper against companies that actually sell systems that include both a transmission and reception system, of which there are many, Acacia instead claims that Defendants induce or contribute to infringement because Defendants' customers "use" the communication system, despite the fact that these customers exercise no control over the transmission portion of the system, and thus make no use of the individual pre-transmission processing elements (such as an "identification encoder" or a "sequence encoder") contained therein. *Compare Faroudja Labs., Inc. v. Dwin Electronics, Inc.*, No. 97-20010 SW, 1999 WL 111788, *2 (N.D. Cal. Feb. 24, 1999).

In making this assertion, Acacia has again employed claim constructions that treat the patent claims as afterthoughts, to be construed after alleging infringement, and not before. Concessions by the applicant in the prosecution history are routinely discarded as are a number of constructions proffered by Acacia to Defendants during discovery. Defendants urge the Court to construe the claims consistent with the intrinsic evidence and circumscribe them to their proper scope as detailed herein.

II. THE PATENT-AT-ISSUE: U.S. PATENT NO. 6,144,702

The '702 patent, the fifth patent in the Yurt family, issued on November 7, 2000—nearly ten years after the applicants filed the application from which it claims priority with the USPTO. The '702 patent includes three independent claims, all of which are directed to a "communication system." The "communication system" comprises both a "transmission system" and a "reception system," which are further defined by each of the claims.

Claims 1 and 6 of the '702 patent read as follows. We have highlighted those terms that the parties have agreed should be construed at this time.[1]

1. A communication system comprising:

a transmission system at a first location in data communication with a reception system at a second location, wherein said transmission system comprises

a sequence encoder,

an identification encoder, and

a compressed data library in data communication with said identification encoder,

wherein said identification encoder gives items in said compressed data library a unique identification code; and

wherein said reception system comprises

a transceiver in data communication with said transmission system,

a storage device in data communication with said transceiver,

user playback controls in data communication with said storage device,

a digital compressor in data communication with said storage device, and

a playback device in data communication with said digital decompressor.

6. A communication system as recited in claim 1, **wherein said identification encoder allows entry of a popularity code.**

In addition, the parties have addressed the "ordering means" limitation from the '992 patent, though Defendants believe that extrinsic evidence may be necessary to construe this claim term.

III. ADDITIONAL LEGAL STANDARDS OF CLAIM CONSTRUCTION

While the Court is well aware of the standards of claim construction, and the parties have addressed in detail many of these standards, a few additional legal principles are applicable to the current claim terms before the Court. We detail those principles below.

A. Functional Claim Limitations, Whether Or Not They Use the Word "Means," are Construed Under § 112, ¶ 6.

Under the patent laws, purely functional claiming—i.e., claiming an apparatus by what it does, not what it is—is prohibited. This prohibition stems from the early

[1] The parties have also proposed constructions for "temporary storage device," which appears in claims 14, 16, 41, and 42.

1900s, when patent practitioners saw "functional" limitations as an easy way to broaden apparatus claims. "By its own literal terms a claim employing such language covers any and all embodiments which perform the recited function." *In re Swinehart*, 439 F.2d 210, 213 (C.C.P.A. 1971). In 1946, however, the Supreme Court invalidated such claims as violating the requirement that claims be sufficiently definite to let the public ascertain the bounds of the invention (i.e., they violated the "public notice" function). *See Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).

In response to *Halliburton*, Congress enacted a compromise in the 1952 revision of the Patent Act–the most recent patent law overhaul. *See Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997). This compromise was 35 U.S.C. § 112, ¶ 6, which the parties extensively addressed in connection with several claim limitations in the '992 patent.

As set forth in Defendants' previous briefs, the use of the word "means" creates a presumption that § 112, ¶ 6 applies, and conversely, the absence of the term "means" creates a rebuttable presumption that it does not apply. *Personalized Media Communications, LLC. v. ITC*, 161 F.3d 696, 704-05 (Fed. Cir. 1998). However, where the limitation does not use the word "means," but nonetheless fails to provide any structure, the limitation invokes § 112, ¶ 6. *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1213 (Fed. Cir. 1998) (holding that the language "lever moving element for moving the lever" invokes § 112, ¶ 6). As the Federal Circuit has emphasized, the lack of traditional "means language" does not prevent a limitation from being subject to § 112, ¶ 6—rather, what controls is whether the limitation connotes structure. *Id.* at 1214. If the limitation is functional, it is subject to § 112, ¶ 6. If it provides sufficient structure to perform the claimed function, then it is not subject to § 112, ¶ 6.

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B. The Legal Test for Determining Whether a Limitation Recites Sufficient Structure

The critical inquiry in determining whether a claim limitation recites sufficient structure is whether the term used in the claim has a reasonably well understood meaning in the art that connotes structure. *Mas-Hamilton*, 156 F.3d at 1213-14. Sufficient structure is not recited where the claim recites a "generic structural term such as 'means,' 'element,' or 'device.'" *Personalized Media*, 161 F.3d 696. Nor is it sufficient to recite a "coined term lacking clear meaning, such as a 'widget' or 'ram-a-fram.'" *Id.*

Under this framework, a number of district courts have construed claims pursuant to § 112, ¶ 6, despite the absence of the word "means" in the limitation. *See e.g., Technology Licensing Corp. v. Videotek Inc.*, 67 U.S.P.Q.2d 1842, 1845-46 (N.D. Cal. 2002) (construing seventeen limitations with the term "section" or "circuit" pursuant to § 112, ¶ 6 for failure to recite sufficient structure); *AMS Am., Inc. v. Genus, Inc.*, 260 F. Supp.2d 827, 855-58 (N.D. Cal. 2002) (construing "apparatus for introducing a purge gas" as a means-plus-function limitation); *Bausch & Lomb Inc. v. Moria S.A.*, 222 F. Supp.2d 616, 632-36, 643-45 (E.D. Pa. 2002) (construing "guide element," "guide assembly," "drive assembly," and "coupling member" under § 112, ¶ 6); *Nilssen v. Motorola, Inc.*, 80 F. Supp.2d 921, (N.D. Ill. 2000) (construing "adjustment input" and "power conditioning circuit" as means-plus-function limitations); *Katz v. AT&T Corp.*, 63 F. Supp.2d 583, 604-08 (E.D. Pa. 1999) (construing "qualification structure" and "recording test structure" pursuant to § 112, ¶ 6).

C. Indefiniteness

When the patent does not clearly link corresponding structure to the recited function of a means-plus-function limitation, the claim is invalid under § 112, ¶ 2. *Cardiac Pacemakers, Inc. v. St. Jude Med. Inc.*, 296 F.3d 1106, 1114 (Fed. Cir. 2002); *see also Competitive Techs. v. Fujitsu Ltd.*, 286 F. Supp.2d 1161, 1175-76, 1190-92, 1209 (N.D. Cal. 2003) (finding seven claims indefinite for failure to identify structure for "sustain means" and "switch means"); *Freeman v. Gerber Prods. Co.*, 284 F. Supp.2d 1290, 1295-98 (D. Kan. 2003) (finding two claims indefinite for failure to identify corresponding structure for "attaching means"); C*ardiac Pacemakers, Inc. v. St. Jude Med. Inc.*, No. IP 96-1718-C H/G, 2000 WL 190121, at *4 (S.D. Ind. Dec. 19, 2000), *aff'd*, 296 F.3d 1106 (Fed. Cir. 2002) (finding a claim indefinite because a physician could not satisfy the patentee's disclosure obligations under §112, ¶6).

Under this authority, Defendants demonstrated that the "identification encoding means" limitation of the '992 patent is fatally indefinite. At the *Markman* hearing, Acacia criticized Defendants' indefiniteness contentions as "not serious" because Defendants' have not provided the Court with expert testimony. As an initial matter, Acacia is well aware of the Court's request that only intrinsic evidence be presented in the briefs and at the hearings. (*See* Dec. 19, 2003 Order Consolidating Related Cases.) But even beyond that, Acacia's assertion that expert testimony is somehow required (or even preferable) for a finding of indefiniteness due to lack of structure is itself "not serious."

"A determination of claim indefiniteness is a legal conclusion that is drawn from the court's performance of its duty as the construer of patent claims." *Personalized Media*, 161 F.3d at 705; *Atmel Corp. v. Information Storage Devices*, 198 F.3d 1374, 1378 (Fed. Cir. 1999). "[A]lthough a court may consider or reject certain extrinsic evidence in resolving disputes en route to pronouncing the meaning of claim language, the court is not crediting certain evidence over other evidence or making factual evidentiary findings." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1376 (Fed. Cir. 2001). "Rather, the court is looking to the extrinsic evidence to assist in its construction of the written document." *Id.*

Thus, whether or not Defendants' present testimony from an expert on claim construction issues has no bearing on the Court's ability to make the legal determination of whether a claim satisfies § 112, ¶ 2 by providing sufficient structure. Indeed, in *Exxon*, the Federal Circuit rejected the argument that the issue of indefiniteness turned on an "underlying factual dispute" and that it should not have been resolved as a matter of law on summary judgment. *Id.* In this regard, in a number of the district court cases provided to the Court in Defendants' Citation of Supplemental Authority, dated April 22, 2004, the district courts found a lack of corresponding structure, without crediting expert testimony, during the claim construction phase of the case. *See e.g.*, *Competitive Techs.*, 286 F. Supp.2d at 1175-76, 1190-92, 1209 (finding one disputed term indefinite without expert testimony and rejecting patentee's expert testimony in finding two other terms indefinite during *Markman*); *Freeman*, 284 F. Supp.2d at 1295-98 (rejecting patentee's expert testimony to find two claims indefinite during *Markman*); *AMS Am., Inc. v. Genus, Inc.*, 260 F. Supp.2d 827, 857-60, 865 (N.D. Cal. 2002) (finding claims invalid during *Markman* without resort to any expert testimony); *Cardiac Pacemakers, Inc.*, 2000 WL 190121, at *4 (same).

IV. DEFENDANTS' PROPOSED CLAIM CONSTRUCTIONS

A. "a transmission system at a first location in data communication with a reception system at a second location"

Independent claims 1, 17, and 27 of the '702 patent all recite "a transmission system at a first location in data communication with a reception system at a second location." This claim limitation is made up of the following constituent phrases: "transmission system," "reception system," "in data communication with," "at a first location," and "at a second location." Defendants' have proposed a construction for each of these phrases in the subsections that follow.

In accordance with these constructions, the Court should construe "a transmission system at a first location in data communication with a reception system at a second location" to mean "an assembly of elements, located at a first single premises, that function together to transmit electrical signals to an assembly of elements, located at a second single premises, that function together to receive the transmitted electrical signals, where the transmitting assembly of elements and the receiving assembly of elements are connected so that electrical signals may be transferred between them."

1. "transmission system": The Court Should Construe this Limitation to Mean an Assembly of Elements That Function Together To Transmit Electrical Signals.

The IEEE dictionary defines "transmission system" as "an assembly of elements capable of functioning together to transmit signal waves." (Ex. NN at 575.)[2] The "assembly of elements" set forth in this definition (i.e., the structure of the transmission system) is further defined in each of the '702 patent claims. The IEEE dictionary defines a "signal wave" as "a wave whose shape conveys some intelligence, message, or effect," and a "wave" as "the variation of current, potential, or power at any point in the electric circuit." (*Id.* at 572, 576.) Accordingly, "signal waves" are best described as electric signals.

These IEEE definitions for "transmission system" are consistent with the use of the term in the patent's written description and its use in the prosecution history. Accordingly, the claim limitation may be given its common dictionary meaning. *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1091 (Fed. Cir. 2003).

2. "reception system": The Court Should Construe this Limitation to Mean an Assembly of Elements That Function Together to Receive Electrical Signals From the Transmission System.

The IEEE dictionary does not provide a definition for "reception system." However, the claims indicate that the transmission system and reception system are in

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[2] Citations to exhibits A-W in this brief refer to the Declaration of Todd G. Miller, which was filed with Defendants' January 8, 2004 Claim Construction Brief. Citations to exhibits X-EE refer to the Supplemental Declaration of Todd G. Miller filed with Defendants' January 22, 2004 Opposition Claim Construction Brief. Finally, exhibits FF- NN are attached to the Declaration of Todd G. Miller In Support of Defendants' Claim Construction Brief Regarding United States Patent No. 6,144,702 filed herewith.

"data communication" with each other. Thus, the reception system receives the electrical signals transmitted by the transmission system. Accordingly, an appropriate construction for the "reception system" is the reciprocal of the "transmission system": an assembly of elements that function together to receive electrical signals from the transmission system. This construction is consistent with the specification's use of "reception system" and its use during the prosecution of the patent. *ACTV,* 346 F.3d at 1091.

3. "in data communication with": The Court Should Construe this Limitation to Mean Connected To Allow the Transfer of Electrical Signals.

The limitation "in data communication with" appears in the claims of the '702 patent 46 times to describe the connection between various elements of the claimed communication system. In claim 1 alone, the phrase defines the connection between the transmission and reception systems, the compressed data library and identification encoder, the transceiver and transmission system, the storage device and transceiver, and so on. Here, we are construing the meaning of "in data communication" with respect to the transmission and reception systems.

The IEEE dictionary provides two definitions for "data communication," each for use in a specific context. The first definition, in the context of power engineering, is "the movement of encoded information by means of communication techniques." (Ex. NN at 569.) The second definition, which applies on the context of computers, is "a data transfer between data source and data destination via one or more data links." *Id.* The first IEEE definition is not particularly useful, as it provides less clarity than the phrase "in data communication with." The same is true of the second definition. Although these definitions are not suitable to adopt for construction, they do provide some guidance in that they demonstrate that "data communication" involves the transmission of electrical signals (i.e., encoded information and computer data).

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The patent specification does not provide any more guidance than the dictionary. Other than in the claims, the phrase "data communication" does not appear in the patent specification a single time. While the specification does not use the claimed phrase, it does describe how the transmission and reception systems exchange data:

> The transmitter 122 places the formatted data onto the communications channel. ...The signal is sent to the reception system 200 in either a two way or a one way communication process. ... In a preferred embodiment of the present invention, many forms of communication channels may be employed. Distribution of information is by common carrier communication channels whenever possible. These channels include common telephone service, ISDN and Broadband ISDN, DBS, cable television systems, microwave, and MAN.

('702 patent at 16:9-22.)

Like the IEEE dictionary definitions, all forms of communication between the transmission and reception systems described in the patent specification involve the exchange of electrical signals. Accordingly, the limitation "in data communication with" should be construed to mean connected to allow the transfer of electrical signals.

4. "at a first location" / "at a second location": The Court Should Construe this Limitation to Mean the Transmission and Reception Systems are Each Located at a Single Premises, Different From Each Other.

The claims of the '702 patent all require the "transmission system" to be "at a first location" and the "reception system" to be "at a second location." The parties previously addressed the term "locations" in connection with the "remote locations" limitation that appears throughout the claims of '992 patent. Defendants' construction of "locations" (plural) was simply "more than one location." (*See* Defs.' January 8, 2004 Claim Construction Br. at 20.) In the '702 patent, the claims use the term "location" (singular), which must be construed to mean a single location. Thus, the relevant inquiry here is the meaning of "location."

The applicants gave meaning to the term "location" both in the written description and during the prosecution of the patent by equating the term with a "premises," and not simply a space (or room) in a premises. In the background section of the patent, the applicants distinguished Walter by stating:

> The Walter patent discloses a fully dedicated, multi-conductor, optical cable system that is wired to the viewer's **premises**. While the system affords the viewer some control over accessing the material, it requires that a **location** be designated by the viewer by [sic] wired with a dedicated cable. The Walter system further requires that viewer to be at that **location** for both ordering and viewing the audio/video material.

('702 patent at 1:30-37) (emphasis added).

The applicants reiterated the intent for "location" to refer to a premises during the prosecution of the '720 patent. The preamble of pending claim 33 of the '720 patent application recited "a transmission system responsive to input from a user positioned at an accessing location for transmitting information to a remote location selected by the user … ." (Ex. HH at 401.) The claim also included the limitation "wherein the remote location may be different from the accessing location." (*Id.* at 402.)

The examiner rejected pending claim 33 in view of U.S. Patent No. 5,133,079 (Ballantyne). Ballantyne discloses a commercial movie distribution system that provides movies to customers on demand. The system stores digitized and compressed motion pictures in a compressed data library for transmission to customers upon request. (Ex. JJ at 3:5-13, 3:59-64.) In making this rejection, the examiner noted:

> The prior art system does not restrict the user to be present at the location, for example in the same room, of the television ("remote

location"). In other words, the phone system ("accessing location") and the television ("remote location") do not have to be at the same location. Ballantyne et al, therefore, teaches all the claimed limitations.

(Ex. HH at 426.) Thus, the examiner interpreted the word "location" to be simply a room or space in a premises, as opposed to a premises.

In response, the applicants cancelled pending claim 33 and added claim 43 in its place, and replaced the word "location" with "premises." The preamble of claim 43 recited "a transmission system responsive to input from a user positioned at an accessing location for transmitting information to a *premises* selected by the user . . . ." (*Id.* at 435) (emphasis added). The "wherein" clause of claim 33 was changed to "wherein the *premises* selected by the user is not limited to a predetermined user *premises*." (*Id.*) (emphasis added).

In conjunction with this amendment, the applicants noted that, in their patent, the word "location" should be construed to mean "premises," and not simply a space or room in a premises:

> Notably, Applicants have used the term "location" to refer to a premises, rather than merely a space in a particular structure. For example, Applicants distinguished U.S. Patent No. 4,506,387, issued to Walter ("the Walter patent") based upon the fact that the system disclosed in the Walter patent requires a dedicated cable wired to the viewer's *premises* and that the viewer be at that *location* for both ordering and viewing the audio/video material.

(*Id.* at 440) (emphasis added).

This concession in the '720 file history, which relies on the previously excerpted statement from the patent specification, is binding on future applications, such as the '702 patent. *See Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990) (holding that, when two patents use the same claim terms, the prosecution histories of both are relevant); *Advanced Cardiovascular*

Systems, Inc. v. Medtronic, Inc., 265 F.3d 1294, 1305 (Fed. Cir. 2001) ("The prosecution history of a related patent can be relevant if, for example, it addresses a limitation in common with the patent in suit."); *Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010 (Fed. Cir. 1997), modifying 122 F.3d 1019 (Fed. Cir. 1997) ("[I]t would be improper to construe this term differently in one patent than another, given their common ancestry.").

Accordingly, based on the use of "location" in the patent specification defining the term as a "premises," and the statements made by the applicants during the prosecution of the '720 patent reaffirming this intent, the Court should construe "location" to mean a premises, and not a space in a particular structure. And because the transmission system and reception system must be "at" the first and second locations (i.e., premises), respectively, the claims require that the transmission system be at one premises (as opposed to many), while the reception system be at another. Accordingly, the court should construe the phrases "at a first location" and "at a second location" to mean that the transmission system is located within (or "at") a single premises, while the reception system is located within (or "at") a single, different premises than the transmission system.

B. The Limitation "identification encoder" is Functional, and Must Be Construed Under 35 U.S.C. § 112 ¶ 6, But Lacks Corresponding Structure in the Patent Specification.

All three independent claims of the '702 patent recite an "identification encoder," a term that was discussed at length by the parties during the construction of the '992 patent. In the context of the '992 patent, Acacia claimed that the "identification encoder" was corresponding "structure" for performing the function of assigning a unique identification code by the claimed "identification encoding means" in Claim 1. (Pl.'s Jan. 22 Opp'n Br. at 21.)

In the '702 patent, the applicants dropped the "means for" language, and while this alternative claiming strategy slightly modifies the analytical framework, the ultimate conclusion does not change. The term "identification encoder" does not have any meaning to those of skill in the art that connotes structure. Thus, like the "identification encoding means" limitation of the '992 patent, the "identification encoder" limitation of the '702 patent fails to satisfy the definiteness requirement of § 112, ¶ 2.

As set forth previously in Defendants' briefs, the patent specification, which is the same for both the '992 and '702 patents, does not describe what an "identification encoder" is or how it performs the function of assigning a UIDC. The patent figures also fail to provide any clue as to the structure of the "identification encoder"—the figures simply depict the "identification encoder" as part of a box labeled "Identification Encoding Process." ('702 patent at FIG. 2a.) Further, the term "identification encoder" does not appear in the IEEE dictionary. Indeed, not a single party to this action has been able to uncover a dictionary definition for the term. This comes as no surprise: as demonstrated at the April 9, 2004 *Markman* hearing, prior art patents cited by Acacia employ the term "identification encoder" in a purely functional fashion to encompass whatever structure is disclosed in the particular patent. Accordingly, even though the claim term does not use the word "means," 35 U.S.C. § 112, ¶ 6 is invoked nonetheless. *See Personalized Media*, 161 F.3d 696. And, as was the case with the '992 patent, no corresponding structure is disclosed.

1. The Phrase "Identification Encoder" is Functional and Under *Personalized Media* Cannot Simply be Defined in a Functional Fashion.

In the context of the '992 patent, Acacia defined the phrase "identification encoder" in its *Markman* briefing by resorting to a combination of the IEEE dictionary definition for a generic "encoder" and the definition of word "identification." (Pl.'s Jan. 22 Opp'n Br. at 24.) In support of this approach, Acacia commented "[i]t is easy to comprehend … that an identification encoder is a device capable of expressing a number, symbol, or name that uniquely identifies certain information … ." (*Id.*)

And, indeed, in employing the IEEE dictionary, the definition of an "identification encoder" would be as Acacia proposes. The IEEE dictionary provides three definitions for the term "encoder": (1) a network or system in which only one input is excited at a time and each input produces a combination of outputs; (2) a device that performs encoding; and (3) a device or system that encodes data. (Ex. NN at 570.) The first definition is not relevant to the claimed system, while the second and third definitions are purely functional, reciting a "device" and a "system" for performing the function of encoding.

These definitions, however, while they aptly define an encoder in functional terms, do not recite any particular structure. Under Federal Circuit authority, the words "device," "system," and the like are generic structural terms that are not connotative of structure. *Personalized Media*, 161 F.3d at 704 (stating that generic structural terms such as "means," "element," and "device" are not a sufficient recitation of structure); *see also Technology Licensing Corp.*, 67 U.S.P.Q.2d at 1845-46 ("section" and "circuit" insufficient); *AMS*, 260 F. Supp.2d at 855-58 ("apparatus" insufficient); *Katz*, 63 F. Supp.2d at 604-08 ("qualification structure" and "recording test structure" insufficient).

Because of the bar on purely functional claiming, simply construing the phrase "identification encoder" as any device or system that encodes an identification (or in the context of the claims, any device or system that encodes a unique identification code and/or a popularity code) is not permissible. Instead, the court must apply 35 U.S.C. § 112, ¶ 6.

2. The Applicants Conceded the Functional Definition During Prosecution.

The applicant's arguments during the prosecution of the '702 patent confirm the functional nature of the "identification encoder." When faced with this limitation, the examiner initially rejected pending claim 1 of the '702 patent as anticipated by U.S. Patent No. 5,130,792 to Tindell. (Ex. GG at 156.) Tindell discloses a system for transmitting digitized and compressed video programs over telephone networks for viewing. (Ex. KK.) Pending claim 1 of the '702 patent had simply recited the "identification encoder" without requiring it to perform the function of assigning a UIDC. (Ex. GG at 123.)

In making her rejection, the examiner cited element 46 of FIG. 3 and column 3, lines 25-27 of the Tindell patent as disclosing an "identification encoder." (*Id.* at 156.) Element 46 of Tindell is labeled "Encoder," and the cited portion of the patent states that "compressed data is input to an encoder 46, which encrypts the data in order to preserve privacy." (Ex. KK at 3:25-27.) In other words, the function of the Tindell encoder was to convert data from one form into another before transmission.

In response, the applicants argued that the examiner had "misinterpreted the claim element of identification encoder," and distinguished Tindell by arguing the functional basis of their "identification encoder":

> In the application, the "identification encoder" is in data communication with compressed data library and the identification encoder gives the items in the compressed data library a unique identification code. The Examiner suggests that encoder 46 of the Tindell patent teaches such a function. However, encoder 46 functions to encrypt data and not to give a unique identification code. Applicants have amended claim 33 to more clearly define the function of the identification encoder of the present invention.

(*Id.* at 164-65.) (internal citations omitted).

To "more clearly define the function of the identification encoder," the applicants added the language "wherein said identification encoder gives items in said compressed data library a unique identification code." (*Id.* at 161, 165.) According to these statements, the claimed "identification encoder" is thus not a generic "encoder," whatever that may be, but rather is a specific "encoder" that gives items a unique identification code—i.e., it has a particular function, but no particular structure, and thus was different from the Tindell "encoder" that performed a different function.

3. Because "Identification Encoder" is a Functional Term, 35 U.S.C. § 112, ¶ 6 applies, But As With the '992 Patent, The Specification Fails to Disclose Corresponding Structure.

Where a claim limitation does not use the word "means," as here, but fails to provide structure, the presumption that § 112, ¶ 6 does not apply is rebutted and the limitation is construed as if it were in means-plus-function format. *Mas-Hamilton*, 156 F.3d at 1213.

The first step in the means-plus-function analysis is to identify the claimed function. *Cardiac Pacemakers*, 296 F.3d at 1113. The claimed functions of the "identification encoder" in the '702 patent are: (1) to assign a unique identification code (claim 1); and/or (2) to allow entry of a popularity code (claims 6 and 27). The next step in the 112, ¶ 6 analysis is to identify the structure that corresponds to the claimed function. *Id.*

For both of the functions performed by the "identification encoder" in the '702 patent claims, the only corresponding "structure" in the patent is the "identification encoder 112." As demonstrated previously in our brief on the '992 patent, at the *Markman* hearing on that patent, and herein again, the patent does not describe any structure for the identification encoder 112, either mechanically or through an algorithm. Since the patent does not describe the structure of the "identification encoder" or how the functions are performed, the patent fails to provide structure corresponding to the claimed functions. *See id.*; *Competitive Techs*, 286 F. Supp.2d at 1175-76, 1190-92, 1209; *Freeman*, 284 F. Supp.2d at 1295-98; *AMS*, 260 F. Supp.2d at 857-60, 865.

Consequently, under § 112, ¶ 6, the claim element fails to recite corresponding structure thus rendering the claim invalid.

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C. The Limitation "sequence encoder" is Functional and is Fatally Indefinite.

The term "sequence encoder" appears in six claims of the '702 patent, including independent claims 1 and 17. Like "identification encoder," the term "sequence encoder" does not appear in the dictionary and has no apparent well-understood meaning to those of skill in the art. It is simply a term the applicants coined by sticking a word in front of "encoder." Adding even more mystery to the meaning of "sequence encoder" is the fact that it does not even appear in the patent's written description—its first and only appearance in the Yurt family is in the claims of the '702 patent. Indeed, the term "sequence encoder" did not even exist until nearly a decade after the parent '992 patent application was filed.

To satisfy the definiteness requirement of § 112, the term "sequence encoder" must have a well-understood meaning to those of skill in the art connotative of structure. *Mas-Hamilton*, 156 F.3d at 1213-14. As set forth in the previous section, the definition of "encoder" does not satisfy this requirement because it provides only generic structural terms. *Personalized Media*, 161 F.3d at 704. Because "sequence encoder" is a purely functional term, and fails to provide structure, the limitation must be construed under § 112, ¶ 6. *Id.*

1. Claims 1 and 17 Do Not Define the Function of the Sequence Encoder, and Therefore, a § 112, ¶ 6 Analysis Fails.

Claims 1 and 17 of the '702 patent recite a "sequence encoder," but do not indicate the function that it performs. Indeed, the only term in the claim that identifies what the "encoder" does is the word "sequence." In Webster's to "sequence" means to place a group of similar or related elements in a continuous or connected series. (Ex. MM at 562.) Thus, the function of the "sequence encoder" is to place related elements in a continuous or connected series. However, this function does not define what is being sequenced, or when and where the process of sequencing occurs in the transmission system.

Turning to the patent, the word "sequence" appears only in the discussion of the "ordering means," which places information (i.e., formatted data) into a sequence of addressable data blocks. ('702 patent at 7:50-52.) The claims are clear, however, that the function performed by the "sequence encoder" of claim 1 should not be limited to this description.

Claim 7 provides "A communication system as recited in claim 1, wherein said sequence encoder transforms digital data blocks into a group of addressable data blocks." The function ascribed to the "sequence encoder" in claim 7 is the exact description of "sequencing" in the patent, as we discuss in greater detail later in the brief. Thus, the claims indicate that the applicants intended the function of the claim 1 "sequence encoder" to be broader than the "sequence encoder" of claim 7.

Indeed, under the doctrine of claim differentiation, each claim in a patent is presumptively different in scope. *Wenger Mfg. v. Coating Mach. Sys.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001). "This presumption is especially strong where there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim, and that limitation is the only meaningful difference between the two claims." *Ecolab, Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1375 (Fed. Cir. 2002). Accordingly, the function of the claim 1 "sequence encoder" must be different from the function recited in claim 7.

As with the patent claims and the written description, the applicants did not attribute any meaning to the term during the patent's prosecution. The prosecution history demonstrates that the examiner attributed two functions to the "sequence encoder" that are different from the only "sequencing" described in the specification—one function for the "sequencing" disclosed in the DeBey patent, and another for the "sequencing" in the Walter patent. These different functions are apparent from a review of the prior art patents relied on by the examiner during prosecution and the examiner's corresponding actions and comments with respect to the patentability of the pending claims.

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In an October 26, 1999 Office Action, the patent examiner rejected all of the pending claims in the '702 patent under § 102 in view of U.S. Patent 5,701,582 issued to DeBey. (Ex. GG at 176.) DeBey discloses a system for transmitting programs over a distribution system for multiple users (i.e., video-on-demand). (Ex. LL at 2:38-44.) In the comments explaining the rejection, the examiner indicated that the "identification encoder" and "sequence encoder" were disclosed in DeBey at FIG. 1, elements 12 and 20 and at column 7, lines 55-61 of the written description. (Ex. GG at 176.)

In FIG. 1 of DeBey, element 12 is labeled a "Storage Distribution Node" and element 20 is called a "Scheduling and Routing Computer." The patent indicates that the storage distribution node routes compressed video material to the appropriate storage medium and controls the flow of data between the different storage devices in the system. (Ex. LL at 4:32-34, 4:49-51.) The scheduling and routing computer "responds to a subscriber request for particular program by retrieving the video program from the appropriate storage media and dividing the video programs into a plurality of video segments." (*Id.* at 6:13-17.) The portion of the description cited by the examiner states that "the head end transmits the video segments in accordance with the scheduling algorithm in a continuous manner, with each video segment provided with a title ID as well as a segment ID … ." (*Id.* at 7:56-59.) The segment ID disclosed in DeBey is a number that is assigned to the video segment. (*See e.g., id.* at FIG. 5.) The number of video segments into which the program is divided depends upon the amount of data in the video program and the desired size of the segment. (*Id.* at 9:29-42.) Thus, from these comments, it would appear that the examiner understood the function of the "sequence encoder" in the context of the DeBey patent to be splitting a program up into segments and assigning each an identifier.[3]

[3] The applicants did not respond substantively to the examiner's rejection. Instead, the applicants maintained that the rejection based upon the DeBey was improper because the reference was not prior art. (Ex. GG at 187.)

Later on in the prosecution, the examiner issued another Office Action rejecting pending claim 33 of the '702 application, which later became claim 1and, at the time, did not include the "sequence encoder" limitation. The examiner rejected pending claim 33 as anticipated by U.S. Patent No. 4,506,387 issued to Walter, which discloses a digital video-on-demand cable system that allows users to request and download video programs from a compressed digital library via high-speed fiber optic cable.[4] (Ex. GG at 193-94.)

In response, the applicants amended pending claim 33 by adding the phrase, "a sequence encoder," to the claim. (*Id.* at 197-98). Based solely on the addition of these three words, the examiner allowed claim 33. The examiner's allowance of claim 33 is puzzling because Walter discloses a method of "sequencing" that is very similar, if not the same, as that disclosed in DeBey.

FIG. 2 of the Walter patent provides a detailed illustration of the central data station (i.e., transmission system), the data receiving station, and the transmission lines between the two stations. (Ex. II at 5:20-22.) The central data station stores the programs that it transmits to the receiving station in storage devices called "memory modules." (*Id.* at 5:30-33.) In the Walter system, each memory module is divided into 16 data cells. (*Id.*) Thus, a single program may be divided into these 16 data cells for storage in a single memory module.

FIG. 3 of the Walter patent, shown below, illustrates an example of a memory module containing three data cells (as opposed to 16) and storing a program consisting of 9 data bits. The data bits in the cells are numbered according to the

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[4] Defendants' provide a more detailed description of Walter in their opening brief for the '992 patent.

order in which they appear in the program:

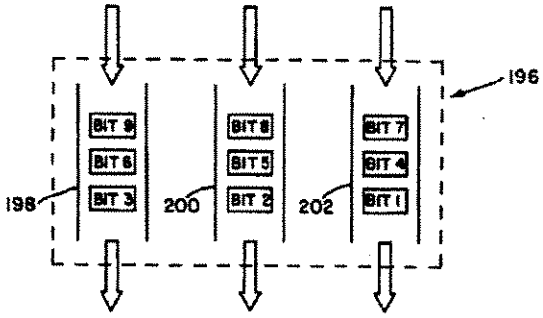

FIG. 3

The system retrieves the data bits from memory in groups of three—one data bit from each of the columns. (*Id.* at 6:32-47.) Thus, the system retrieves data bits 1, 2, and 3 at the same time. Next, it retrieves data bits 4, 5, and 6, and so on. (*Id.*) To allow this type of retrieval, the data bits must be sequenced in the memory modules as shown in FIG. 3. (*Id.*)

In addition to the individual data bits, the central data station transmits "synchronization data" to the receiving system. (*Id.* at 6:23-25.) The synchronization data allows the bits to be stored in a similar fashion at the receiving station. (*Id.* at 7:6-11.) Once placed in memory by the receiving station, the sequenced data bits are retrieved from memory, reassembled as discussed previously, and fed into a digital-to-analog converter for broadcast on a television. (*Id.* at 7:12-16.)

As shown in FIG. 3 above, Walter discloses a method of "sequencing," wherein a program is split up into segments (i.e., data bits) and assigned a number identifier. This "sequencing" is akin to the "sequencing" disclosed in DeBey, yet the examiner allowed claim 1 of the '702 patent to issue with only the addition of "a sequence encoder." Accordingly, the "sequence encoder" of claim 1 of the '702 patent must be different that that of Walter, but at the same time, be the same as that of DeBey. This only further demonstrates that "sequence encoder" does not have a well-known meaning, or for that matter, a well-understood function. Indeed, the intrinsic evidence provides three different functions—the function described in claim 7 (and in the patent's written description) and the two functions ascribed to the term by the examiner during prosecution.

Because claims 1 and 17 do not define the function performed by the "sequence encoder," and the intrinsic evidence fails to fill the gap, the Court cannot construe the claim pursuant to § 112, ¶ 6. Accordingly, claims 1 and 17 do not satisfy the definiteness requirement of § 112, ¶ 2, and are therefore invalid.

D. "wherein said identification encoder allows entry of a popularity code": The Court Should Construe this Limitation to Mean the Identification Encoder Is Set Up to Permit the Entry of a Code That Is Used By the Transmission System to Determine the Appropriate Location and Media Format for Storage of Compressed Data Associated With the Code Based on the Relative Popularity of the Compressed Data Among Users of the Transmission System.

Claim 27 of the '702 patent contains the limitation "wherein said identification encoder allows entry of a popularity code." Claim 6, which depends from claim 1, also includes this limitation. The term "popularity code" does not have a common meaning available from a dictionary, technical or otherwise. The dictionary definitions from Webster's of the constituent words "popularity" and "code" provide some guidance:

- Popularity: the quality or state of being popular (Ex. MM at 561.)
- Code: any system of symbols for meaningful communication (*Id.* at 560.)

However, merely forming a construction through a combination of these words without resort to the specification is not appropriate under Federal Circuit caselaw. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003).

The patent's specification states that the "popularity code" is assigned during a process called storage encoding, which also involves giving an item a UIDC and logging details called program notes. ('702 patent at 6:35-39.) The "popularity code" performs a specific function in the disclosed transmission system, which is not implicit from the definitions of the words "popularity" and "code." The patent specification states:

> The popularity code is preferably assigned on the basis of how often the corresponding item is expected to be requested from the compressed data library 118. This popularity code can be used to determine the most appropriate form of media for storage of the compressed data in a mixed media system. Mixed media systems are preferably employed as more cost effective storage in very large compressed data libraries 118. Once assigned, the popularity code may be dynamically updated, by factoring item usage against system usage. Thus, stored items are dynamically moved to the most appropriate media over their life in the compressed data library 118. If a particular item stored in compressed data library 118 is retrieved frequently by users, storage in compressed data library 118 is preferably on higher speed, more reliable, and probably more expensive media.
>
> * * *
>
> If an item stored in compressed data library 118 is retrieved less frequently, it may be stored in the compressed data library 118 on a digital cassette tape.
>
> * * *
>
> In some cases, where multiple compressed data libraries 118 are organized, the popularity code may dictate distribution of a particular item to multiple distribution systems.

('702 patent at 12:4-47.)

Accordingly, the patent defines a popularity code as a code that is used by the transmission system to determine the appropriate location and media format for storage of compressed data associated with the code based upon the relative popularity of the compressed data among users of the transmission system. And because the "identification encoder" must permit entry of such a code, the "identification encoder" must be set up to accept such a code and use it as a popularity code. Accordingly, the limitation "wherein said identification encoder allows entry of a popularity code" should be construed to mean: "the identification encoder is set up to permit entry of a code that is used by the transmission system to determine the appropriate location and media format for storage of compressed data associated with the code based upon the relative popularity of the compressed data among users of the transmission system."

E. "digital compressor": This Claim Limitation Should be Construed as a "Digital Compressor" and is Not Subject to Re-Interpretation by the Court.

In claim 1 of the '702 patent, the reception system includes "a digital compressor in data communication with said storage device." The term digital compressor is described throughout the patent specification and the term appears in a number of claims. On April 15, 2003, the PTO issued a certificate of correction for this limitation, which replaced the word "compressor" with "decompressor." (Ex. FF.)

A certificate of correction is only effective for causes of action arising after the certificate is issued. *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1294 (Fed. Cir. 2000). For causes of action that arise before the correction becomes effective, the patent must be considered without the benefit of the correction. *Id.* at 1297. Here, the causes of action against Defendants arose before the correction, and thus the '702 patent must be considered without the benefit of the correction.

The version of claim 1 in effect for this lawsuit recites a reception system that includes a "digital compressor." The patent specification discloses a digital compressor in the transmission system of the claimed communication system, *see e.g.*, Figure 2a, but nowhere in the patent is a digital compressor shown as part of the reception system. A comparison of the patent specification to claim 1 of the '702 patent shows that the applicants did not regard a reception system with a "digital compressor" to be their "invention." "Where it would be apparent to one of skill in the art, based on the specification, that the invention set forth in a claim is not what the patentee regarded as his invention, [this court] must hold that claim invalid under § 112, paragraph 2." *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.2d 1336 (Fed. Cir. 2002). Accordingly, the "compressor" limitation renders the claim invalid for indefiniteness. *Id.*

In *Allen Engineering*, the Federal Circuit addressed this same issue under nearly identical facts. In that case, the claims limited one of two recited steering boxes "to pivoting its gear box *only* in a plane *perpendicular to* said biaxial plane." *Id.* at 1349. The patentee argued, and the court acknowledged, that "one of skill in the art would understand that the term 'perpendicular' in the claim should read to mean 'parallel.'" *Id.* The court stated, however, that "[i]t is not our function to rewrite claims to preserve their validity." *Id.* Because it was apparent to the court from a comparison of the claims and the specification that the inventor did not regard a pivot in a perpendicular plane as his invention, the court concluded, as a matter of law, that the claims including the "incorrect perpendicular limitation" were invalid under § 112, ¶ 2. *Id.*

Recently, in *Novo Industries, L.P. v. Micro Molds Corp.*, the Federal Circuit further addressed the ability of a district court to correct claim errors. 350 F.3d 1348 (Fed. Cir. 2003). In *Novo*, the court held that district courts "can continue to correct obvious minor typographical and clerical errors in patents." *Id.* at 1357. At the same time, the court acknowledged that "major errors are subject only to correction by the PTO," citing *Southwest Software*, where the court held that the district court could not correct the a error in the patent—the omission of an appendix containing 330 pages of text—even though the PTO had appropriately done so. *Id.* Where a minor error is correctable, "[a] district court can correct a patent only if (1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims. *Id.* at 1357.

Under these cases, the Court may not rewrite claim 1 and replace "compressor" with "decompressor," as the PTO has done, for causes of action arising before April 15, 2003. The error in claim 1 is not an obvious minor typographical or clerical error that is subject to correction by the Court. This fact is evidenced by the patentee's request for a certificate of correction. If the error is minor, then a certificate of correction was not necessary—the Court could simply correct the claim. The actions of the PTO further demonstrate that the error is not minor. According to the *Patent Office Rules and Practice*, "mistakes which are too trivial, inconsequential, or obviously recognized will not warrant the issuance of a certificate of correction." *Id.* at 1356 (citing § 323 [A][1]). Indeed, if the error was minor and obviously recognized, the PTO would not have issued a certificate of correction. Since the error is not obviously recognized and thus subject to a reasonable debate, the Court may not rewrite the language of claim 1. Accordingly, the claim does not recite what the applicants believed was their "invention" and the claim is invalid under § 112, ¶ 2.

F. "transceiver": The Court Should Construe this Limitation to Mean a Combination of a Transmitter and a Receiver in a Common Housing that Uses Common Circuit Components for Both Transmitting and Receiving.

All three independent claims of the '702 patent recite a "transceiver" in data communication with the transmission system. The IEEE dictionary defines a "transceiver" as: (1) The combination of radio transmitting and receiving equipment in a common housing, usually for portable or mobile use, and employing common circuit components for both transmitting and receiving, and (2) A combination transmitter and receiver in a single housing, with some components being used by both parts. (Ex. NN at 574.) Similarly, Webster's defines "transceiver" as "[*transmitter* + *receiver*]: a radio transmitter-receiver that uses many of the same components for both transmission and reception." (Ex. MM at 564.) These definitions are consistent with the patent's use of transceiver and the use of the term in prosecution history. Accordingly, the claim limitation may be given its common dictionary meaning. *ACTV*, 346 F.3d at 1091.

G. "temporary storage device": The Court Should Construe this Limitation to Mean a Device that Stores Electronic Data that can be Overwritten.

The term "storage device" appears in the three independent claims of the '702 patent. A few dependent claims, namely claims 14, 16, 41, and 42, further recite "wherein said storage device is a temporary storage device." In the context of the claims, the term "storage device" does not refer to all devices that store, such as shelves, boxes, and drawers. Rather, the storage devices recited in the claims store electronic data. The specification provides a number of examples of electronic storage devices, including computer tapes, computer disks, cartridges, and digital cassette tapes. ('702 patent at 6:16-19, 12:21-29.)

The IEEE dictionary does not include a definition for "temporary storage device." However, the IEEE definition of "temporary storage" and Webster's definition of "temporary" provide guidance. IEEE defines "temporary storage" as "storage locations reserved for intermediate results." (Ex. NN at 573.) Webster's defines "temporary" as "lasting for a limited time only: existing or continuing for a limited time: IMPERMANENT, TRANSITORY." (Ex. MM at 563.) Consistent with these definitions, a "temporary storage device" is a storage device capable of storing data on an intermediate, or impermanent, basis. Put simply, the electronic data in the storage device must be capable of being overwritten. Accordingly, the Court should construe "temporary storage device" to mean a device that stores electronic data that can be overwritten.

H. The '992 patent "ordering means": The Court Should Find the Corresponding Structure to Be the Time Encoder With its Associated Algorithms.

Claim 1 of the '992 patent recites an "ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks." The parties have already submitted proposed constructions for the phrase "sequence of addressable data blocks," which is part of the function performed by the "ordering means." (*See* Defs.' Claim Construction Br. at 38-39.) In accordance with Defendants' proposed construction of this phrase, the Court should construe the function to mean placing the formatted data into a continuous series of memory units that contain digital information that can be given an identifier.

Once the Court construes the function of the "ordering means," the Court must then determine what structure, if any, disclosed in specification corresponds to the claimed function." *Cardiac Pacemakers*, 296 F.3d at 1113. The patent specification provides the following:

> The transmission system 100 of the present invention also preferably includes ordering means for placing the formatted information into a sequence of addressable data blocks. As shown in FIG. 2a, the ordering means in the preferred embodiment includes time encoder 114. After the retrieved information is converted and formatted by the converter 113, the information may be time encoded by the time encoder 114. Time encoder 114 places the blocks of converted formatted information from converter 113 into a group of addressable blocks.

('992 patent at 7:59-8:1.) According to the patent, the preferred embodiment of the "ordering means" includes a "time encoder." The "time encoder" is the preferred, and only, "structure" in the patent that corresponds to the function of placing the formatted information into a sequence of addressable data blocks.[5]

Unlike the "identification encoder" and "sequence encoder," which were addressed in previous sections, the patent actually places some bounds on the structure of the time encoder by providing an algorithm that it must perform, consistent with the requirements of cases like *WMS Gaming, Inc v. Int'l Game Tech.*,

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[5] The specification indicates that the "time encoder" places the blocks of converted information into a *group* of addressable blocks. The patent states also states that "[t]he *sequence* of addressable data blocks data blocks which was time encoded and output by time encoder 114 is preferably sent to precompression processor 115." ('992 patent at 8:59-62.) Thus, it appears that the terms "group" and "sequence" are used interchangeably in the patent.

184 F.3d 1339 (Fed. Cir. 1999). The specification provides the following algorithm that bounds the time encoder from any device that encodes the sequence of addressable data blocks to the following:

> The converted formatted information of the requested material is then preferably in the form of a series of digital data bytes which represent frames of video data and samples of the audio data. A preferred relationship of the audio and video bytes to each other is shown in FIG. 8. Incoming signals are input and converted in sequence, starting with the first and ending with the last frame of the video data, and starting with the first and ending with the last sample of the audio data. Time encoding by time encoder 114 is achieved by assigning relative time markers to the audio and video data as it passes from the converter 113 through the time encoder 114 to the precompression processor 115.

(*Id.* at 8:7-19.)

Put simply, the algorithm performed by the "time encoder" includes receiving a series of digital data bytes that represent video and audio data. The video and audio data in the series are mixed together—i.e., the audio and video data are next to each other in the series. *See* FIG. 8d. The "time encoder" converts the series into a "sequence" where all of the video data is grouped together starting from the first frame to the last frame, and all of the audio data is grouped together starting with the first and ending with the last sample of audio data.

At this point in the process, the function set forth in the claim has been performed—the formatted data has been placed into a continuous series of memory units that contain digital information that can be given an identifier. After the data has been placed into this sequence, the "time encoder" then places time markers on the video frames and audio samples, which allows later realignment of the video and audio data.

Accordingly, the Court should find the structure that corresponds to the function of the "ordering means" to be "a time encoder that receives a series of data bytes that represents audio and video data, wherein the audio and video data is commingled in the series, and placing the audio and video in a sequence where all of the video data is in a group, starting with the first and ending with the last frame of video, and all of the audio data is in a group, starting with the first and ending with the last sample of audio data. In an additional embodiment, time markers are placed on the video frames and audio samples.

V. CONCLUSION

For the foregoing reasons, Defendants request that the Court construe the disputed claim limitations as requested herein.

Dated: May 7, 2004

FISH & RICHARDSON P.C.

By: /s/
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing DEFENDANTS' CLAIM CONSTRUCTION BRIEF REGARDING UNITED STATES PATENT NO. 6,144,702 was served on this date upon all counsel of record as follows:

Via United States District Court, Central District of California, Electronic Case Filing Program, by uploading the electronic files for the above listed document.

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Executed at San Diego, California this 7th day of May, 2004.

/s/
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